

REMARKS

Applicant has amended claim 1 to address the examiner's objection. However, for claim 11, Applicant does not see what portion of claim 11 is informal because "A" only appears at the beginning of the claims which is proper and the objection to claim 11 should be withdrawn. Applicant also has amended claim 9 to address the examiner's objection. However, for claim 19, Applicant does not believe that claim 19 contains multiple sentences and the objection to this claim should be withdrawn.

In response to the examiner's requirement for information, Applicant is unaware at this time of any information (non-patent literature, published applications or patents) that were used in the invention process to derive the formula set forth in claims 2 and 12.

PRIOR ART REJECTIONS

In response to the examiner's rejection of claims 1-4 and 11-14 as being anticipated by WO 02/23443 to Flynn ("Flynn"), the rejection of claims 5-6, 8, 15-16 and 18 as being obvious over Flynn in view of US Patent Application Publication No. 2003/0105689 to Chandak et al. ("Chandak"), the rejection of claims 7 and 17 as being obvious over Flynn and Chandak and further in view of US Patent Application Publication No. 2003/0225651 to Chen ("Chen") and the rejection of claims 10 and 20-23 as being obvious over Flynn in view of US Patent Application Publication No. 2004/0054553 to Zizzamia et al. ("Zizzamia"), Applicant traverses the rejections because, as set forth below, each claim element is not disclosed in Flynn and therefore Flynn does not anticipate the independent claims and the combination of Flynn and the other prior art do not teach or suggest each claim element and therefore the examiner has not established a *prima facie* case of obviousness.

Claims 1-4 and 11-14

Claims 1 and 11

The examiner has asserted that independent claims 1 and 11 are anticipated by Flynn. However, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Appl. No. 10/623,352
Reply dated July 31, 2008
Reply to Office Action mailed January 31, 2008

Furthermore, "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). *See also MPEP 2131 et seq.* In this rejection, the anticipation rejection for each independent claim is improper because each claim element is not found in Flynn for the reasons set forth below.

Claim 1 recites "said program collects historical contractor variables and comprises a formula that generates contractor risk assessment score based on the historical contractor variables wherein the contractor risk assessment score is predictive of a performance worthiness of a contractor" which is not described in Flynn. Claim 11 recites a similar element.

Flynn discloses a method and apparatus for producing reduced risk loans (See Title) for a construction loan or trade loan. *See Flynn at pg. 11, lines 3-6.* To determine the risk of the loan, the system gleans data from the loan application and a financial&property/project questionnaire and stores the information in character (Loan Applicant's reputation), financial (Loan Applicant's past and current financial data), property (real estate information used for construction loans), legal (contractual terms) and project risk assessment files (for a trade loan request.) *See Flynn at pg. 12, lines 7-18.* Flynn system uses the information in the risk assessment files to generate raw scores. *See Flynn at pg. 13, lines 5-6.*

However, Flynn does not describe collecting historical contractor variables or a formula that generates contractor risk assessment score based on the historical contractor variables wherein the contractor risk assessment score is predictive of a performance worthiness of a contractor. Flynn describes a loan risk assessment system and has nothing whatsoever to do with a contractor risk assessment score that uses historical contractor variables as set forth in claims 1 and 11. Thus, each claim element is not described in Flynn and the anticipation rejection must be withdrawn.

Claims 2-4 and 12-14

These claims depend from claims 1 and 11 and the anticipation rejection of these claims must be withdrawn for the same reasons as claims 1 and 11.

Furthermore, claims 2 and 12 recite a particular formula for calculating the contractor risk assessment score which is not described in Flynn and the anticipation rejection of these claims must be withdrawn for at least this additional reason.

Claims 5-6, 8, 15-16 and 18

The examiner has rejected these claims as being obvious over Flynn in view of Chandak. Pursuant to MPEP § 2143, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and the prior art reference must teach or suggest all the claim limitations. *See M.P.E.P. § 2143*. Also, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

For these claims, because Flynn does not disclose certain claim elements of the independent claims from which these claims depend, the combination of Flynn and Chandak do not teach or suggest each claim element and therefore the examiner has not established a *prima facie* case of obviousness and the rejection must be withdrawn.

Claims 7 and 17

The examiner has rejected these claims as being obvious over Flynn and Chandak and further in view Chen. However, because Flynn does not disclose certain claim elements of the independent claims from which these claims depend, the combination of Flynn, Chandak and Chen do not teach or suggest each claim element and therefore the examiner has not established a *prima facie* case of obviousness and the rejection must be withdrawn.

Claims 10 and 20-23

The examiner has rejected these claims as being obvious over Flynn in view of Zizzamia. However, because Flynn does not disclose certain claim elements of the independent claims from which these claims depend, the combination of Flynn and Zizzamia do not teach or suggest each

Appl. No. 10/623,352

Reply dated July 31, 2008

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claim element and therefore the examiner has not established a prima facie case of obviousness and the rejection must be withdrawn.

CONCLUSION

In view of the above, it is respectfully submitted that Claims 1-23 are allowable over the prior art cited by the Examiner and early allowance of these claims and the application is respectfully requested.

The Examiner is invited to call Applicant's attorney at the number below in order to speed the prosecution of this application.

The Commissioner is authorized to charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 07-1896.

Respectfully submitted,

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